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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,479	09/04/2003	Jonathan Helitzer		8693
28120	7590	11/17/2006	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
				3626
DATE MAILED: 11/17/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/656,479	HELITZER ET AL.	
	Examiner	Art Unit	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 August 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 23-38 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 23-38 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>21 Sept./06 & 6 Nov./06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 25 August 2006. Claims 1-22 have been cancelled. Claims 23-38 have been newly added. Claims 23-38 remain pending. The Information Disclosure Statements filed 21 September 2006 and November 6, 2006 have been entered and considered.

Election/Restrictions

2. The requirement for restriction and election of claims is hereby withdrawn due to the amendment filed 25 August 2006.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Newly added claims 34, 38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Claims 34, 38 recite limitations that are new matter, and are therefore rejected.

The added material which is not supported by the original disclosure is as follows:

- "initiating, by the insurance company, a remedial action," as disclosed in claim 34, lines 1-2; and
- "receiving, by the insurance company, the data output by the insurance company," as disclosed in claim 38, lines 1-2.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 4 September 2003. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 4 September 2003.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 25–26, 33, 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 25–26 recite "wherein receiving data ... comprises" in lines 1-2, respectively;
- Claim 33 recites "the data received" in line 2; and
- Claim 38 recites "receiving, by the insurance company, the data output by the insurance company" in lines 1-2.

There is insufficient antecedent basis for these limitations in the claims. For the purpose of applying art, examiner interprets claim 38 to read "receiving, by the insurance company, the data output by the incorporated technology."

8. The rejection of claim 5 under 35 U.S.C. 112, second paragraph, for being indefinite is hereby withdrawn due to the amendment filed 25 August 2006.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

NOTE: The following rejections assume that the subject matter added in the 25 August 2006 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 3-5 above in the next communication sent in response to the present Office Action.

10. Claims 23-24, 31-34, 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Prendergast et al., U.S. Patent Number 5, 842, 148.

(A) As per claims 23-24, 31, Prendergast teaches a method for insuring a building structure by taking into account technologies that militate against loss comprising the steps of: maintaining a database identifying a plurality of technologies that reduce risk of loss to an associated building structure (Prendergast; column 2, lines 29-34);

insuring, by an insurance company, a building structure incorporating a technology from the plurality of technologies identified in the database (Prendergast; column 6, line 58 to column 7, line 2); Examiner interprets Prendergast's teachings of "insurance carriers... may decide to give structures getting a favorable rating much lower insurance rates" to teach this limitation; and

giving "lower insurance rates" to "structures getting a favorable rating" reads on "altering terms of the insurance policy based on data output by the incorporated technology" (Prendergast; column 6, line 58 to column 7, line 2).

wherein altering the terms of the insurance policy comprises giving "lower insurance rates" (reads on "altering the premium") (Prendergast; column 6, line 58 to column 7, line 2);

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and

comprising receiving, by the “carrier” (reads on “insurance company”) the data output by the incorporated technology (Prendergast; Abstract, column 6, line 58 to column 7, line 2).

(B) As per claims 32-34, 37, Prendergast teaches a method for insuring a building structure by taking into account technologies that militate against loss comprising the steps of:

maintaining a database identifying a plurality of technologies that reduce risk of loss to an associated building structure (Prendergast; column 2, lines 29-34);

insuring, by an insurance company, a building structure incorporating a technology from the plurality of technologies identified in the database (Prendergast; column 6, line 58 to column 7, line 2); Examiner interprets Prendergast’s teachings of “insurance carriers... may decide to give structures getting a favorable rating much lower insurance rates” to teach this limitation;

determining the condition of the insured building structure based on data output by the incorporated technology (Prendergast; column 2, lines 15-39, column 6, line 41 to column 7, line 2);

comprising detecting, by the insurance company, a dangerous condition at the insured building based on the data received from the incorporated technology (Prendergast; column 2, lines 51-61, column 6, line 58 to column 7, line 2);

comprising initiating, by the insurance company, a remedial action to the detected dangerous condition (Prendergast; column 7, lines 2-4); and

wherein the condition of the insured building is determined by the insurance

company (Prendergast; column 6, line 58 to column 7, line 2); Examiner interprets Prendergast's giving "lower insurance rates" to "structures getting a favorable rating" to be a form of determination of the condition of the insured building by the insurance company.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 25-30, 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prendergast et al., U.S. Patent Number 5, 842, 148, as applied to Claim 23, above, and further in view of Lloyd et al., U.S. Patent Number 5, 950, 150.

(A) As per claim 25, Prendergast teaches a method as analyzed and discussed in claim 23 above.

Prendergast fails to explicitly disclose a method wherein receiving data output by the incorporated technology comprises receiving data indicating the functional status of the incorporated technology.

However, this feature is well-known in the art as evidenced by Lloyd.

In particular, Lloyd teaches a method

wherein receiving data output by the incorporated technology comprises receiving data indicating the functional status of the incorporated technology (Lloyd; Abstract, Figure 14, Item 810, column 24, lines 1-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Prendergast to include these limitation, as taught by Lloyd, with the motivations of “providing a system and method capable of notifying insurers, property management companies, building/structure owners or other interested entities of any discrepancies or deviations in the preparedness of fire/life safety systems” and in this way “improve fire/life safety, minimize risk, and reduce the loss of life and property” (Lloyd; column 7, lines 24-28, column 8, lines 56-68).

(B) As per claims 26-30, 35-36 Prendergast teaches a method as analyzed and discussed in claims 23 and 32 above

Prendergast fails to explicitly disclose a method wherein receiving data output by incorporated technology comprises receiving data indicating the condition of the insured building structure;

the data output by the incorporated technology is output over a communications network;

the data output by the incorporated technology is output via a broadcast transmission; the incorporated technology comprises a risk mitigation technology; and the technology comprises a risk mitigation technology.

However, Lloyd teaches a method wherein

receiving data output by incorporated technology comprises receiving data indicating the condition of the insured building structure (Lloyd; column 8, line 60 to column 9, line 11, column 24, lines 1-18);

the data output by the incorporated technology is output over a communications network (Lloyd; column 11, lines 49-57);

the data output by the incorporated technology is output via a broadcast transmission (Lloyd; column 11, lines 49-57);

the incorporated technology comprises a risk mitigation technology (Lloyd; column 8, lines 54-58); and

the technology comprises a risk mitigation technology (Lloyd; column 8, lines 45-58); comprising receiving, by the insurance company, the data output by the insurance company (Lloyd; column 8, lines 8-24).

The motivations for combining the respective teachings of Prendergast and Lloyd are as given in the rejection of claim 25 above, and incorporated herein.

Response to Arguments

13. Applicant's arguments on page 4 of the response filed 25 August 2006 with respect to newly added claims 23-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

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17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Natalie A. Pass

November 8, 2006

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

November 9, 2006


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER